

Remarks

The Office Action dated August 12, 2009, indicated that the 35 U.S.C. § 101 rejection of claims 1-45 has been withdrawn. The Office action dated August 12, 2009, also listed the following rejections: claims 3 and 5 stand newly rejected under 35 U.S.C. § 112(1); claims 1-2, 4, 6, 8-16, 21, 23-28, 30, 32-36, 42-49, 51, 53-59, 63-66, 68, 70 and 74 stand rejected under 35 U.S.C. § 103(a) over Hamlin (U.S. Patent No. 5,574,964) in view of Ellis *et al.* (U.S. Patent Publication No. 2005/0251827); claims 3 and 5 stand rejected under 35 U.S.C. § 103(a) over Hamlin in view of Ellis, and in further view of an unidentified “Edson” reference; claims 7, 22, 29, 31, 37-41, 67 and 75 stand rejected under 35 U.S.C. § 103(a) over Hamlin in view of Ellis, and in further view of Edens *et al.* (U.S. Patent No. 6,611,537); claims 17-19, 52 and 60-62 stand rejected under 35 U.S.C. § 103(a) over Hamlin in view of Ellis, and in further view of Cohen *et al.* (U.S. Patent No. 4,837,798); claims 20 and 50 stand rejected under 35 U.S.C. § 103(a) over Hamlin in view of Ellis, and in further view of Goldstein (U.S. Patent No. 5,410,326); and claims 69 and 71-73 stand rejected under 35 U.S.C. § 103(a) over Hamlin in view of Ellis, and further in view of Lewis (U.S. Patent No. 5,835,126). In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise. In addition, as many of the rejections of various claims are based upon the same alleged correspondence to specific claim limitations, Applicant fully incorporates its traversals of record by reference.

The new rejection of claims 3 and 5 rely upon an “Edson” reference without specifying a particular citation. Applicant has addressed this new rejection based upon the ‘581 reference in the PTO form (PTO-892), and requests clarification regarding the same.

All of the rejections are improper because they rely upon a misinterpretation of frequency-based communication channels as corresponding to frequency-based data configuration, the former of which is simply to ensure that the right data gets to the right place, and the latter of which (as claimed) actually involves reconfiguring the data for use at a particular device (e.g., configuration to a process-readable format). The frequency-based communication in the primary ‘964 reference involves communicating different data streams over different frequencies so that end devices can “listen” on a desired frequency. The pods in the ‘964 reference can listen on all frequencies, and data sent to the respective end devices can also be sent over any frequency. The frequency used in the ‘964 reference is thus for

communication routing purposes and has no bearing upon the ability of end devices to actually use the data.

The Examiner's misinterpretation may be further understood in reviewing the Response to Arguments at page 3 of the Office Action, which erroneously asserts that the frequency conversion is "necessary for the interface pod and corresponding end device to receive the content." While the Examiner is correct in that the '964 reference requires that a particular frequency be used to communicate data to a particular pod, this communication frequency is irrelevant to the respective end device's ability to process the received data. As described throughout the '964 reference, while the respective pods listen at a particular frequency or frequencies, they are capable of listening on all frequencies and, further, the format of the data has nothing to do with the communication frequency. Referring to column 6:25-28, the pods 44 are effectively directed to listen on different communication frequencies depending upon the desired signal to be sent thereto (e.g., a different television channel), yet these frequencies do not affect the actual data being sent, or the ability of the end device (e.g., a VCR) to process the data that is received.

Referring to independent claims 46, 55 and 65 by way of example, the cited frequency conversion in the '964 reference accordingly has no bearing upon the claimed configuration to a "processor-readable" format amenable for use at a particular end device, or to configuring data between "executable" formats. Moreover, as each signal that is received in the 964 reference is already configured for use by a particular end device (see, e.g., column 1:66-2:3), there is no reason to modify those signals as claimed (see, e.g., independent claim 46).

Further addressing the Examiner's response to arguments and claim 16, the Examiner's comments at page 4 regarding the '964 reference's use of non-packet-based data are not germane to Applicant's traversals. These traversals do not assert that the '964 reference does not communicate frequency-converted signals in a non-packet-based format (such an assertion would be erroneous), but rather that the '964 reference does not *alter* the format of data from a first format (e.g., a packet-based format) into a different non-packet-based format (e.g., a processor-readable format). As discussed above, the '964 reference simply changes the frequency medium over which the data is communicated, and does not alter the format of the data itself. Accordingly, the cited combination of references fails to disclose related limitations in claim 16.

Regarding claims 2 and 4 and as consistent with the above, the '964 reference is not concerned with any "processor-readable format"; instead, it is directed to simply slotting data into a frequency at which a pod device is listening. Specifically regarding claim 4, the Office Action fails to mention anything about configuring external services data into a different processing format AND into a different communications format. As discussed above, the '964 reference is concerned only with communications and carries out no processor-based configuration.

Accordingly, the '964 reference fails to disclose or even contemplate various aspects of the claimed invention "as a whole" (§ 103(a)) including aspects regarding frequency-translating signals for application-specific use at an end device. The '964 reference does not disclose, teach or suggest various claim limitations directed to frequency translation for arriving at the claimed invention, including those aspects directed to configuring data so that a particular appliance can use the data (e.g., independently from any manner in which the data is communicated to the appliance). Because none of the cited references teaches aspects of the claimed invention directed to device-specific frequency translation, no reasonable interpretation of the asserted prior art, taken alone or in combination, can provide correspondence. As such, the rejections fail.

Applicant further submits that the rejections are improper because they are based upon a misinterpretation of the 2007 *KSR* Decision (and the September, 2008 BPAI Decision referenced at page 5 of the Office Action), in effectively asserting an "obvious to try" argument that both contradicts the *KSR* decision and more-recent (2009) law that clarifies the obviousness standard set forth in *KSR*.^{1,2} Specifically, the *Kubin* court specified that an "obvious to try" argument as presented herein is impermissible. More is required, such as guidance from the asserted prior art that sets forth the particular form of the claimed invention or otherwise describes how to achieve it. Interpreting *KSR*, the *Kubin* court explained two situations in which the "obvious to try" standard under § 103(a) may not be applied:

- (1) where one would have "to vary all parameters ... where the prior art gave either no indication of which parameters were critical ..."; or

¹ *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007)

² *In re Kubin*, 561 F.3d 1351 (Fed. Cir. 2009)

(2) an area of “new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.”³

In this instance, nothing in the record establishes that the ‘964 reference would be modified to operate in accordance with configured data as claimed (e.g., how a VCR could process reformatted video data), or would include other components in various claim limitations such as those directed to control configurations, security configurations, and packet-switching over a twisted pair bus. In fact, as described further below, the ‘964 reference teaches away from modifying data as claimed, as it does not appear that the respective end devices could process data configured into a different format. Accordingly, one of skill in the art would be motivated to maintain the configuration of the data being sent, and modify only the frequency over which the data is communicated for routing purposes. The rejections thus rely (at best) upon an impermissible “obvious to try” argument that fails to provide any explanation as to how the ‘964 reference’s frequency-based routing approach could or would operate as claimed. As such, the rejections fail.

All of the § 103 rejections are further improper because the cited references teach away from the Office Action’s proposed combination. Consistent with recent case law, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main reference - the rationale being that the prior art teaches away from such a modification. *See KSR at 1742* (“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.”). *See also In re Gordon, 733 F.2d 900 (Fed. Cir. 1984)* (A §103 rejection cannot be maintained when the asserted modification undermines purpose of the main reference.).

In this instance, Applicant submits that the proposed modification of the ‘964 reference to reconfigure data being sent into a different (e.g., processor-readable) format would render the reference inoperable for its purpose to “distribute multiple received signals having different formats .. to various locations within a structure without requiring unique reception equipment at each of the specific locations.” The end devices remain compatible with the received signals, which are simply routed on a particular communication frequency and not configured as

³ *In re O’Farrell*, 853 F.2d 894 quoting at 903 (Fed. Cir. 1988)

discussed above. As one example, the '964 reference routes data to a VCR that is configured to receive television signals, and does so via the pods 44, which are used to determine which television signals go to which VCR (or other device). The Office Action provides no explanation as to how configuring the television signal into a different format would provide a signal useable by the VCR. Similar reconfigurations would appear to also be inconsistent with the '964 reference's purpose of providing signals in their native configuration to end devices for which the signals are intended. Accordingly, the proposed modification would render the '964 reference inoperable for its purpose, and there is thus no motivation for making the modification.

Applicant respectfully traverses the newly-presented § 112 rejections because the rejection appears to be an erroneous attempt to require that the specification disclose word-for-word correspondence, contrary to M.P.E.P. § 2163. Regarding claim 3, the claim limitations are directed to performing a non-frequency-based reconfiguration of external services data to configure data into a new format for use by a particular appliance. The rejection is based upon an assertion that the specification does not recite "non-frequency-based reconfiguration." However, the specification describes multiple example embodiments involving a configuration that is not frequency based, such as by "converting the data from a first form to a second form, such as from analog to digital or packet-based to non-packet-based" (see page 7:21-22). Converting data from analog to digital, or from packet-based to non-packet-based, are clear examples of non-frequency-based data conversion.

Regarding claim 5, the rejections are based upon an assertion that the specification does not recite communicating data in a packetized format including a packet header that identifies a destination packet-based address. However, the specification clearly recites packet-based busses such as a user bus (*see, e.g.*, page 10:17-24, and describes Internet (packet-based) communications over a bussing arrangement). Such packet-based communications use a packet header to route data, as consistent with packet-based communications and as well understood in the art (*e.g.*, the Internet). Should the Examiner remain confused about packet-based communications, a telephone call to the undersigned is invited.

In view of the above, Applicant believes that the § 112 rejections are improper and should be removed.

Selected Aspects of Applicant's Previous Response Arguments

The following re-emphasizes Applicant's previous response, which is applicable here and fully incorporated herein by reference. The following discussion sets forth Applicant's belief that the primary reference (and all combinations therewith) does not disclose, teach or suggest claim limitations including those directed to configuring data for use at an end device. Rather, the primary reference simply frequency-converts data for communicating the data to a particular receiving device over an exclusive range of bandwidth available on a particular communications link. Applicant further believes that the primary reference and related combinations do not disclose limitations directed to configuring and communicating external services data over a packet-based network, using packet headers to address respective end devices (*i.e.*, with data for different end devices communicated on overlapping frequencies).

Applicant submits that the § 103 rejections are improper because the cited frequency translation of incoming signals of the '964 reference does not correspond to the claimed configuration of data into a format usable by a particular end device (*see, e.g.*, independent claim 1). This frequency translation also has no bearing upon the claimed configuration to a "processor-readable" format amenable for use at a particular end device (*see, e.g.*, independent claims 46 and 65), or to configuring data between "executable" formats (*see, e.g.*, independent claim 55). Generally, the purpose of the '964 reference is to use a single cable, such as an existing television cable, to communicate different signals throughout a home without having to wire different cables to handle different services, as consistent with the "operational example" beginning at column 5:10. The cited frequency translation in the '964 reference is thus made simply to enable the communication of different incoming signals over a common bus to a particular destination, by translating each of several incoming signals to a mutually-exclusive frequency band as discussed in connection with FIG. 5 at column 5:1-7. Referring to FIG. 1, which is copied below for convenience, the '964 reference achieves its purpose by frequency-converting incoming signals at converter 34 and transmitting the frequency-converted signals on a cable 36 to different pods 44.

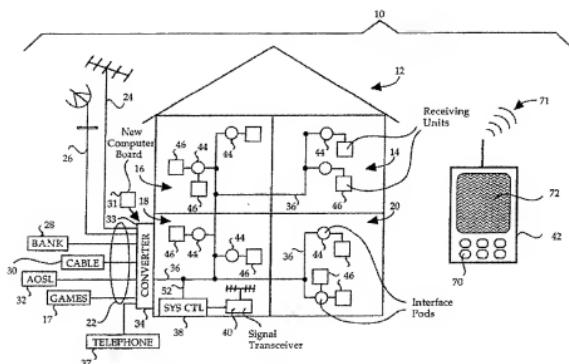


Fig. 1

Once received at the pod, the signal is converted back into a format consistent with its original format, such as back into a format pertaining to a particular received television channel. For instance, as described at column 6:29-65, received television channels are passed to an end device (a VCR) in a television channel format, where the VCR is capable of directly receiving such television channels.

Accordingly, the purpose of the frequency conversion in the '964 reference is to allow communications on a common cable, where the receiving units generally operate as if directly receiving the signals "without requiring unique reception equipment at each of the specific locations" (see column 2:3-6). No portion of the '964 reference appears to disclose or contemplate any configuration of stored (or received) external-services data for use at a particular appliance based on capabilities of the appliance, as all configuration in the '964 reference appears solely to effect the communication of data over a common cable. Moreover, as each signal that is received in the 964 reference is already configured for use by a particular end device (see, e.g., column 1:66-2:3), there is no reason to modify those signals as claimed (see, e.g., independent claim 46). Therefore, the '964 reference and various combinations therewith fail to disclose, teach or suggest limitations directed to configuring "the external-services data for use at a particular one of the plurality of appliances in the user facility, based upon capabilities of the particular one of the appliances..." as in claim 1.

In view of the above, Applicant believes that each of the independent claims should be allowable over the '964 reference in the various combinations as asserted, as each combination fails to disclose, teach or suggest limitations as directed above.

Applicant further submits that the '964 reference, alone or in combination with other references as cited, fails to disclose, teach or suggest various limitations in the dependent claims. For example, regarding the rejection of claim 16, the asserted ability of the "converter 34 being able to convert from mass media signals or internet signals to a signal that is communicated on the bus 36" is unsupported in the '964 reference, nor does it provide any indication that its frequency conversion alters data into a non-packet-based format. Rather, it appears that the conversion is for communication purposes only, and has no bearing upon the type of data. As is well-known, packet-based data such as satellite television data can be frequency converted to render the data amenable to communication to a particular device, without changing the configuration of the data itself.

Applicant also submits that the '964 reference fails to disclose, teach or suggest limitations in the previously-amended dependent claims. Specifically regarding claim 2, the cited references do not disclose configuring data into a different processor-readable format required by an end device to which the data is sent. Regarding claim 3, the cited references fail to disclose performing a non-frequency-based reconfiguration of external services data to configure the data into a new format for use by a particular appliance. Regarding claim 4, the cited references fail to disclose configuring external-services data into a different processing format for use by a processing circuit in a particular type of end device, and packaging the configured external-services data into a different communications format for communicating the data to the particular end device. Regarding claim 5, the cited references fail to disclose communicating stored external services data in a packetized format using data packets including a packet header that identifies a destination packet-based address to which the stored external services data is to be sent, where such a bussing arrangement communicates data on common frequencies.

For at least these reasons, and further for those reasons of record (which are fully incorporated herein), Applicant believes that the rejections are improper and should be removed. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

CRAWFORD MAUNU PLLC
1150 Northland Drive, Suite 100
St. Paul, MN 55120
651/686-6633

Dated: October 12, 2009

By: 

Robert J. Crawford
Reg. No. 32,122
Eric J. Curtin, Reg. No. 47,511